

REMARKS

I. Status of the Claims

Claims 1-32 are pending. Claims 1-22 stand rejected. Claims 23-32 are withdrawn from consideration by the Examiner as being directed to non-elected subject matter. No claims have been amended in this reply.

II. Rejection of claims 1-22 under 35 U.S.C. § 103(a)

The Examiner maintains the rejection of claims 1-22 under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 6,540,791 to Dias ("Dias"), in view of U.S. Patent No. 6,260,556 to Legrand et al. ("Legrand"), and further in view of U.S. Patent No. 6,423,306 to Caes et al. ("Caes"). Final Office Action, page 2. The Examiner asserts that Dias, Legrand, and Caes disclose the components of the claimed composition. Advisory Action, page 2. The Examiner further alleges that "Dias discloses water content as low as 2.5% and non-aqueous formulations such as solid, powder, mascara, and paste[.]" *Id.* Applicant respectfully disagrees for the reasons of record and for the additional reasons below.

The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. See M.P.E.P. § 2142. In *KSR Int'l Co. v. Teleflex Inc.*, 82 U.S.P.Q.2d 1385 (2007), the Supreme Court confirmed that the "framework for applying the statutory language of §103" was still based on its landmark decision in *Graham v. John Deere Co. of Kansas City*, 148 U.S.P.Q. 459 (1966). Under *Graham*, there are four factors for consideration when determining whether an invention is obvious: (1) the scope and content of the prior art; (2) the differences between the prior art and the claims at issue; (3) the level of ordinary skill in the art; and (4) secondary

considerations. 148 U.S.P.Q. at 467. "Such evidence . . . may include evidence of . . . unexpected results." M.P.E.P. § 2141. The obviousness or non-obviousness of the claimed invention is then evaluated in view of the results of these inquiries. See *Graham*, 148 U.S.P.Q. 467; see also *KSR*, 82 U.S.P.Q. 2d at 1388.

Applicant respectfully reiterates that the Examiner has failed to articulate "reasoning with some rational underpinning" for why one of ordinary skill would choose to modify Dias to arrive at the presently claimed anhydrous paste, and therefore failed to establish a *prima facie* case of obviousness. First, Applicant maintains that the Examiner has not articulated a rationale as to why a person of ordinary skill in the art would modify Dias to include the gelling agents taught by Caes. Second, Applicant maintains that Dias teaches away from an anhydrous product having a water content less than 1% by weight relative to the total weight of the paste as currently recited in the claims. Third, Applicant maintains that Examiner has failed to provide any reason why a person of ordinary skill in the art would modify the range of polydecene disclosed in Dias to arrive at the claimed range.

In addition, Dias discloses polydecene amongst a long list of organic conditioning oils, including mineral oil and fatty acid esters such as isopropyl myristate and isopropyl palmitate. See Dias Col. 22, line 42 - Col. 25, line 15. The instant specification discloses the drawbacks of using long chain hydrophobic fatty acid esters, including sensitivity to extreme temperatures. See specification as filed at ¶¶ [010] - [013]. In further support of the arguments on record, Applicant concurrently submits the Declaration under 37 C.F.R. § 1.132 of Florence Laurent ("Declaration"). Submission of the Declaration in no way indicates that Applicant concedes that the Examiner has

established a *prima facie* case of obviousness. Instead, the Declaration clearly shows the unpredictability of the art and unexpected results attributable to the inclusion of polydecene in the claimed composition.

The first series of comparative testing submitted herewith in the Declaration is between inventive composition A, a composition comprising polydecene, and comparatives compositions B, C, and D, comprising vaseline, isopropyl myristate, and isopropyl palmitate, respectively. These anhydrous paste compositions were placed in a freezer at -21°C for 16 hours and then measured for firmness by penetrometry measurements. The test results show that the paste formulated with polydecene remains malleable at low temperature, whereas the comparative compositions were solid and brittle.

The second series of comparative testing submitted in the Declaration is between inventive composition E, a composition comprising polydecene, and comparatives compositions F and G, comprising vaseline and isopropyl palmitate, respectively. These anhydrous paste compositions were placed in a freezer at -21°C for 16 hours and then measured for firmness by penetrometry measurements. The test results show that the paste formulated with polydecene remains malleable at low temperature, whereas the comparative compositions were solid and brittle.

These results are unexpected in view of Dias, Caes and Legrand. Therefore Applicant respectfully submits that this rejection should be withdrawn.

Conclusion

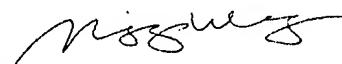
In view of the foregoing remarks, Applicant respectfully requests reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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Dated: May 4, 2009

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Attachment: Declaration under 37 C.F.R. 1.132 of Florence Laurent